

RECEIVED
CENTRAL FAX CENTER

JAN 24 2007

Atty. Dkt. No. 200301736-2REMARKS

Claims 1-58 were pending; of these, claims 5-14, 29 and 31-43 are withdrawn from consideration as being drawn to a non-elected species. Claims 1-4, 15-28, 30 and 44-58 were rejected. By the above amendment, applicants have amended claims 1 and 45. The applicants request further consideration and re-examination in view of the amendment above and remarks set forth below.

To summarize prosecution of the subject application so far, five office actions have been issued, each relying on a different reference or combination of references to reject the applicant's claims. In response to each of the first four office actions, the applicants pointed out how the claims are patentably distinguishable over the cited references. The current office action mailed on September 26, 2006, is the fifth substantive office action in the application. As explained in detail below, the claims are patentable over the references now being relied upon. In view of numerous actions having been issued and rejections overcome, the applicants submit that the claims have been thoroughly examined and are now due for allowance. Because the present application has now been pending for over six years, allowance at an early date would be greatly appreciated.

Information Disclosure Statement:

With the applicants' response filed July 1, 2005, the applicants' submitted an information disclosure statement, together with form PTO/SB/08B listing U.S. Provisional Patent Application 60/206,580 to Nemovicher. This Nemovicher provisional application was discussed in the applicants' remarks filed July 1, 2005, regarding claim rejections. In the office action mailed August 8, 2005, the rejections were indicated as overcome, which the applicants gratefully acknowledge. However, the office action mailed on August 8, 2005, did not appear to include a copy of the form PTO/SB/08B with respect to the Nemovicher provisional application with the examiner's initials showing that the Nemovicher provisional application was considered. The applicants pointed this out in the response filed on November 8, 2005, and again in the response filed on May 14, 2006, and requested that consideration of the Nemovicher provisional application be made of record in the application file. However, a copy of the form

Atty. Dkt. No. 200301736-2

PTO/SB/08B with the examiner's initials showing that the Nemovicher provisional application was considered does not appear to have been entered into the file at any time.

Therefore, the applicants again respectfully request that a copy of the form PTO/SB/08B with the examiner's initials showing that the Nemovicher provisional application was considered be included in the official file for the application. For the convenience of the examiner, the applicants have attached a copy of the information disclosure statement and form PTO/SB/08B which was submitted on July 1, 2005.

Rejections under 35 U.S.C. § 112:

Claim 1 is rejected as being indefinite because the term "its" allegedly lacks antecedent basis. Though the applicants disagree with the rejection, the applicants have amended claim to no longer use the phrase "its backup partners." Further, the MPEP at Section 2173.05(e) provides guidance on the antecedent basis requirement of 35 U.S.C. § 112:

A claim is indefinite when it contains words or phrases whose meaning is unclear. The lack of clarity could arise where a claim refers to "said lever" or "the lever," where the claim contains no earlier recitation or limitation of a lever and where it would be unclear as to what element the limitation was making reference. Similarly, if two different levers are recited earlier in the claim, the recitation of "said lever" in the same or subsequent claim would be unclear where it is uncertain which of the two levers was intended. A claim which refers to "said aluminum lever," but recites only "a lever" earlier in the claim, is indefinite because it is uncertain as to the lever to which reference is made. Obviously, however, the failure to provide explicit antecedent basis for terms does not always render a claim indefinite. If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. >*Energizer Holdings Inc. v. Int'l Trade Comm'n*, 435 F.3d 1366, 77 USPQ2d 1625 (Fed. Cir. 2006)(holding that "anode gel" provided by implication the antecedent basis for "zinc anode"); <*Ex parte Porter*, 25 USPQ2d 1144, 1145 (Bd. Pat. App. & Inter. 1992) ("controlled stream of fluid" provided reasonable antecedent basis for "the controlled fluid"). Inherent components of elements recited have antecedent basis in the recitation of the components themselves. For example, the limitation "the outer surface of said sphere" would not require an antecedent recitation that the sphere has an outer surface. See *Bose Corp. v. JBL, Inc.*, 274 F.3d 1354, 1359, 61 USPQ2d 1216, 1218-19 (Fed. Cir 2001) (holding that recitation of "an ellipse" provided antecedent basis for "an ellipse having a major

Atty. Dkt. No. 200301736-2

diameter" because "[t]here can be no dispute that mathematically an inherent characteristic of an ellipse is a major diameter").

MPEP at Section 2173.05(e) (Aug. 2006). Referring to claim 1, as amended, it recites forming one or more backup partnerships among a plurality of computers. It also recites that "each computer in a backup partnership commits under an agreement to store backup data received from one or more of its backup partners" (underlined portions added and stricken portions deleted). From this, it is clear that each computer in a backup partnership has backup partners. Accordingly, a person of ordinary skill in the art will easily understand that the recited "backup partners" are those computers in the backup partnership with the recited "each computer." Therefore, claim 1, as amended, clearly defines what is meant by "backup partners." Claim 45 is amended in a similar manner.

Claims 1-4, 15-28, 30 and 44-58 are rejected as being indefinite because the term "or" in the phrase "one or more partnerships" allegedly causes the claims to encompass elements "not actually disclosed." Section 2173.05(d) of the MPEP is relied upon in the rejection.

The applicants respectfully traverse the rejection. The phrase "one or more" will be easily understood to mean "at least one." Accordingly, this phrase does not render the claim indefinite. Further, the provisions of Section 2173.05(d) of the MPEP relate to exemplary language: "such as" and "for example." The phrase "one or more" is not exemplary language and is not among the phrases discussed in 2173.05(d) of the MPEP. Accordingly, this section of the MPEP is inapplicable to phrase "one or more."

In view of the above, the applicants respectfully request that the rejections under 35 U.S.C. § 112 be removed.

Rejections under 35 U.S.C. § 103:

Claims 1-4, 15-28, 30 and 44-58 are rejected under 35 U.S.C. § 103 as being obvious in view of U.S. Patent No. 4,631,664 to Bachman (hereinafter "Bachman"), in view of U.S. Patent No. 5,771,354 to Crawford (hereinafter "Crawford"). Regarding claim 1, the office action states that Bachman discloses all of its elements at col. 3, line 21 to col. 4, line 58 and col. 5, line 13 to col. 8, line 40, except that Bachman "fails to mention a partnership in backing up data." However, the office action states that:

Atty. Dkt. No. 200301736-2

Crawford teaches an Internet online backup system interactively establishes backup services which allows one (or more) partnership ("Diagnostics and Maintenance Services (block 204) include various programs stored on virtual disks to checkout, troubleshoot, and enhance the customer computer 50. Diagnostic programs can detect problems with memory or system board components. Peripheral management programs can be used for testing, alignment, storage maintenance, etc., to improve device throughput. Hardware errors detected by diagnostic programs during a customer automated session can trigger repair service based on a maintenance agreement. ") among plurality of computers (100, 120). In one preferred embodiment, replica computer 160 is capable of operating in an on-line mode or in an off-line mode. In the on-line mode, the replica computer 160 communicates interactively with customer computer 50 to perform processing tasks. In this on-line mode in the preferred embodiment, the customer computer 50 and the on-line replica computer 160 cooperate to support processing in either and/or both processors (shared access to data buffers and a record locking scheme is used to ensure safe access). In the off-line mode, replica computer 160 performs personal computer tasks in response to direction from host computer 104 without having an on-line, interactive link with customer computer 50.

The business practice of backing up data is notoriously well known in information management. To back up data for the purpose of a secure record management and to improve load balancing, reduction or elimination of fragmentation, and to prevent loss of data from an occurrence of a multiple storage failure.

It would have been obvious to make use of the partnership database management of Bachman to allow data management to store, retrieve, and modifies data records in computers over the network to include data backup as one of its services offered to customer(s)/client(s)/partner(s) in view of the express suggestion in Crawford.

The applicants respectfully traverse the rejection. To establish a *prima facie* case of obviousness, three basic criteria must be met: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and finally, the prior art reference references must teach or suggest all the claim limitations. MPEP at Section 2143 (Aug. 2006). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *Id.* at Section 2143, citing *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Moreover, when applying 35 U.S.C. § 103, the following tenets of patent law

Atty. Dkt. No. 200301736-2

must be adhered to: (A) the claimed invention must be considered as a whole; (B) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) reasonable expectation of success is the standard with which obviousness is determined. MPEP at Section 2141 (Aug. 2006), citing *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986). When these principles are followed, it is apparent that the applicants' claimed invention is not obvious in view of the cited references.

Bachman is directed toward database management systems. Bachman at col. 1, lines 7-8, and at col. 3, lines 10-11. Bachman discusses that a database is a physical and logical arrangement of data records and that database management systems allow storage, accessing and modification of data records within a database. Bachman at col. 1, line 51, to col. 2, line 14. Bachman discusses that prior database management systems suffered from drawbacks in their inability to adequately represent a full range of relationships among objects. Bachman at col. 2, line 14, to col. 3, line 9. Bachman attempts to overcome this alleged drawback by incorporating two principles into a database management system: first, the concept of joining pairs of data records in "partnerships"; and, second, the concept of attaching of number of related partnerships to a "record." Bachman at col. 3, lines 41-45. The "partnerships" of Bachman are defined as a "structure which establishes a logical relation between two records" in which "access to either one of the two records assures access to other record." Bachman at col. 4, lines 13-18. The partnership data model structures described by Bachman may be combined in various ways to build data structures. Bachman at col. 4, lines 30-32.

Therefore, the applicants agree that Bachman does not teach a partnership in backing up data, as in applicants' claim 1. Further, the "partnerships" discussed by Bachman are entirely unrelated to the partnerships recited in applicants' claim 1 because they relate solely to a logical relation between two data records in which access to one record assures access to another record. This "partnership" is entirely distinct from the partnerships of applicants' claim 1 at least because the partnerships of claim 1 are among computer systems. In fact, Bachman does not teach or suggest any form of partnerships

Atty. Dkt. No. 200301736-2

among computer systems. Moreover, Bachman does not teach anything related to backing up data. In contrast, the applicants' claim 1 is directed toward partnerships among computer systems for backing up data. In view of these differences, it is clear that Bachman is in an entirely different field of endeavor from applicants' claim 1 and does not teach any of the elements of applicants' claim 1.

Further, claim 1 recites that "a first computer in each partnership assumes the task of storing backup data received from one or more other computers in the partnership and one or more of the other computers in the partnership assume the task of storing backup data received from the first computer...". Therefore, claim 1 requires a reciprocal partnership in which each computer in a partnership stores data of the others. Bachman clearly does not disclose such a feature since Bachman teaches nothing about partnerships among computers and teaches nothing about backing up data.

Crawford also does not teach or suggest the features of applicants' claim 1 that are missing from Bachman. Particularly, Crawford is directed toward on-line services that provide automated information processing to computer users for a fee. Crawford at col. 1, lines 9-12. Among the services provided is an archival service in which customer files are copied to on-line service virtual disks for offsite archiving. Crawford at col. 14, lines 45-48. Thus, it is clear from Crawford that this archiving service is provided to the customer by on-line service in exchange for payment. In other words, the provision of services is one-way. Therefore, applicants' claim 1 is distinguishable from this aspect of Crawford since applicants' claim 1 requires a reciprocal partnership in which each computer in a partnership stores data of the others.

The office action alleges that the "replica computer 160" of Crawford discloses features of applicants' claims. According to Crawford, the replica computer 160 is included in the on-line service's information server 100 and is the same type of computer as is a customer's computer 50. Crawford at col. 17, lines 1-6, and at Figure 4. The replica computer 160 adds processing capabilities to the information server 100 and may be used to perform the same types of processing that the customer's computer 50 is capable of performing. Crawford at col. 17, lines 7-12. The applicants' claim 1 is distinguishable from this aspect of Crawford because there is no teaching or suggestion in

Atty. Dkt. No. 200301736-2

Crawford that the "replica computer 160" might perform any functions of a reciprocal partnership for backing up data.

In marked contrast to the one-way type of services disclosed by Crawford, applicants' claim 1 requires that each computer in a partnership commits under an agreement to store backup data received from one or more of its backup partners. In other words, claim 1 requires the exchange of services for services among the computers of the partnerships (i.e. the agreements are two-way among the backup partners). Neither Crawford, nor Bachman, teaches or suggests this feature of applicants' claim 1. For at least this reason, claim 1 is allowable over Bachman and Crawford, taken singly or in combination.

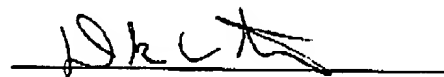
Similarly to claim 1, independent claims 45, 48 and 49 each require that a first computer in each partnership assumes the task of storing backup data received from one or more other computers in the partnership and one or more of the other computers in the partnership assume the task of storing backup data received from the first computer. As explained above, Bachman and Crawford, taken singly or in combination, do not suggest or disclose such a feature. Accordingly, claims 45, 48 and 49 are allowable over Bachman and Crawford. Claims 2-4, 15-28, 30, 44, 46, 47 and 50-52 are allowable at least because each depends from an allowable base claim.

Further, claim 49 recites exchanging messages among computers of the plurality to determine the ability of each to satisfy backup storage requirements of one or more others. The applicants submit that neither Bachman, nor Crawford disclose such a feature. This is another reason why claim 49 is allowable. This is also another reason why claims 50 and 51 are allowable, being dependent from claim 49.

Atty. Dkt. No. 200301736-2Conclusion:

In view of the above, the applicants submit that all of the rejected claims are allowable. Allowance at an early date would be greatly appreciated. Should any outstanding issues remain, the examiner is encouraged to contact the undersigned at (408) 293-9000 so that any such issues can be expeditiously resolved.

Respectfully Submitted,

Dated: Jan. 24, 2007

Derek J. Westberg (Reg. No. 40,872)